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PATENT AND TRADEMARK OFFICE

SEP 28 2006

PATENT APPLICATION

In re Application of: **Edmonds et al.** Attorney Docket No.: **SEDN/246DIV3**

Serial No.: **09/805,492** Group Art Unit: **2616**

Filed: **March 13, 2001** Examiner: **Chevalier, Robert**

Confirmation #: **1945**

For: **METHOD AND APPARATUS FOR PERFORMING SUB-PICTURE
LEVEL SPLICING BASED ON INTERRUPTS**

VIA FACSIMILE 571 273 8300
OFFICE OF PETITIONS

MAIL STOP PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or being facsimile transmitted to the USPTO, on the date indicated below.	
Date	<i>8 pages</i> <i>9/28/2006</i> <i>Laura E. Grater</i> LAURA E. GRATER

SIR:

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR 1.47(b)

Reconsideration of the Office's September 25, 2006 dismissal of the October 22, 2001 Petition for filing of patent application when all inventors refuse to execute papers or cannot be reached under 37 CFR 1.47(b) (hereinafter "the Petition") is respectfully requested.

The Petition was dismissed for insufficient proof of proprietary interest. The Petition was supported by the Declaration of Stephanie Storms, Senior Vice President/General Counsel of DIVA Systems Corporation (hereinafter "the Company"). As set forth in Ms. Storms' Declaration, the invention was made by Applicants while employees of the Company. In Employee Invention Assignment and Confidentiality Agreements (hereinafter, "the Agreements"), Applicants agreed that "all Inventions ... will be the sole and exclusive property of the Company [DIVA Systems Corporation]." The Agreements were referred to in Ms. Storms' Declaration, but copies were not

provided. Copies of the Agreements executed by Applicants are attached to this Request for Reconsideration.

Petitioners respectfully submit that the Agreements establish sufficient proprietary interest in the subject matter to justify filing of the application under 37 CFR 1.47(b). As such, Petitioners respectfully request that the Petition be granted. Prompt consideration of this Request for Reconsideration is respectfully requested. The application has been allowed, and the issue fee has been paid.

Although Petitioners do not believe that any fee is due in connection with this Request for Reconsideration, if Petitioners are incorrect, please charge counsel's Deposit Account No. 20-0782/SEDN/246DIV3 in the amount of any fee due.

Respectfully submitted,

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Dated: 9/28/06


Eamon J. Wall, Attorney
Registration No. 39,414

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

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DIVA Systems Corporation
EMPLOYEE INVENTION ASSIGNMENT AND CONFIDENTIALITY AGREEMENT

In consideration of, and as a condition of my employment with DIVA Systems Corporation, a Delaware Corporation having a principal place of business at 333 Ravenswood Ave., Bldg. 205, Menlo Park, California 94025, its subsidiaries, affiliates, successors or assigns (together the "Company"), and in consideration of my receipt of the compensation now and hereafter paid to me by Company, I hereby represent to, and agree with the Company as follows:

1. **Purpose of Agreement.** I understand that the Company is engaged in a continuous program of research, development, production and marketing in connection with its business and that it is critical for the Company to preserve and protect its Proprietary Information (as defined below), its rights in Inventions (as defined below) and all related intellectual property rights. Accordingly, I am entering into this Agreement as a condition of my employment with the Company, whether or not I am expected to create inventions for value for the Company.
2. **Disclosure of Inventions.** I will promptly disclose in confidence to the Company all inventions, improvements, designs, original works of authorship, formulas, processes, compositions of matter, computer software programs, databases, mask works and trade secrets ("Inventions") that I make or conceive or first reduce to practice or create, either alone or jointly with others, during the period of my employment, whether or not in the course of my employment, and whether or not such Inventions are patentable, copyrightable or protectible as trade secrets.
3. **Work for Hire; Assignment of Inventions.** I acknowledge and agree that any copyrightable works prepared by me within the scope of my employment are "works for hire" under the Copyright Act and that the Company will be considered the author and owner of such copyrightable works. I agree that all Inventions that (i) are developed using equipment, supplies, facilities or trade secrets of the Company, (ii) result from work performed by me for the Company, or (iii) relate to the Company's business or current or anticipated research and development (collectively "Assigned inventions"), will be the sole and exclusive property of the Company and are hereby irrevocably assigned by me to the Company.
4. **Labor Code 2870 Notice.** I have been notified and understand that the provisions of paragraphs 3 and 5 of this Agreement do not apply to any Assigned Invention that qualifies fully under the provisions of Section 2870 of the California Labor Code, which states as follows:

(a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

- (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
- (2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

5. **Assignment of Other Rights.** In addition to the foregoing assignment of Assigned Inventions to the Company, I hereby irrevocably transfer and assign to the Company: (i) all worldwide patents, patent applications, copyrights, mask works, trade secrets and other intellectual property rights in any Assigned Invention; and (ii) any and all "Moral Rights" (as defined below) that I may have in or with respect to any Assigned Invention. I also hereby forever waive and agree never to assert any and all Moral Rights I may have in or with respect to any Assigned Invention, even after termination of my work on behalf of the Company. "Moral Rights" mean any rights to claim authorship of an Assigned Invention, to object to or prevent the modification of any Assigned Invention, or to withdraw from circulation or control the publication or distribution of any Assigned Invention, and any similar right, existing under judicial or statutory law of any country in the world, or under any treaty, regardless of whether or not such right is denominated or generally referred to as a "moral right."
6. **Assistance.** I agree to assist the Company or its designee in every proper way to obtain for the Company or its designee and enforce for the Company or its designee patents, copyrights, mask work rights, trade secret rights and other legal protections for the Company's Assigned Inventions in any and all countries. I will execute any documents that the Company or its designee may reasonably request for use in obtaining or enforcing such patents, copyrights, mask works, trade secrets and other legal protections. My obligations under this paragraph will continue beyond the termination of my employment with the Company, provided that the Company or its designee will compensate at a reasonable rate after such termination for time or expenses actually spent by me at the Company's request on such assistance. I appoint the Secretary of the Company as my attorney-in-fact to execute documents on my behalf for this purpose.
7. **Proprietary Information.** I understand that my employment by the Company creates a relationship of confidence and trust with respect to any information of a confidential or secret nature that may be disclosed to me by the Company that relates to the business of the Company or to the business of any parent, subsidiary, affiliate, customer or supplier of the Company or to any third party with whom the Company agrees to hold information of such party in confidence ("Proprietary Information"). Such Proprietary Information includes but is not limited to Inventions owned by the Company (including any Assigned Inventions), marketing plans, product plans, business strategies, financial information, personnel information, customer lists and subscriber lists. Proprietary Information does not include any information which is or becomes part of the public domain, unless it becomes such as a result of a breach of this Agreement.
8. **Confidentiality.** At all times, both during my employment and after its termination, I will keep and hold all such Proprietary Information in strict confidence and trust, and I will not use or disclose any of such Proprietary Information without the prior written consent of the Company, except as may be necessary to perform my duties as an employee of the Company for the benefit of the Company. Upon termination of my employment with the Company, I will promptly deliver to the Company all documents and materials of any nature pertaining to my work with the Company and I will not take with me any documents or materials or copies thereof containing any Proprietary Information.
9. **No Breach of Prior Agreement.** I represent that my performance of all of the terms of this Agreement and my duties as an employee of the Company will not breach any invention assignment, proprietary information or similar agreement with any former employer or other party. I represent that I will not bring with me to the Company or use in the performance of my duties for the Company any documents or materials of a former employer that are not generally available to the public or have not been legally transferred to the Company.
10. **Duty Not to Compete.** I understand that my employment with the Company requires my undivided attention and effort. As a result, during my employment, I will not, without the Company's express written consent, engage in any employment, consulting or other business activity which directly or indirectly competes with the business or future business plans of the Company, nor will I engage in any other activities that conflict with my obligations to the Company.

11. **Notification.** I hereby authorize the Company to notify my actual or future employers of the terms of this Agreement and my responsibilities hereunder.
12. **Non-Solicitation.** During, and for a period of one (1) year after termination of, my employment with the Company, I will not directly or indirectly solicit customers, employees or consultants of the Company for my own benefit or for the benefit of another party.
13. **Injunctive Relief.** I understand that in the event of a breach or threatened breach of this Agreement by me the Company may suffer irreparable harm and will therefore be entitled to injunctive relief to enforce this Agreement.
14. **Governing Law; Severability.** This Agreement will be governed and interpreted in accordance with the internal laws of the State of California, without regard to or application of choice of law rules or principles and shall be binding upon and inure to the benefit of the parties, and their respective heirs, personal representatives, successors and assigns. In the event that any provision of this Agreement is found by a court, arbitrator or other tribunal to be illegal, invalid or unenforceable, then such provision shall not be voided, but shall be enforced to the maximum extent permissible under applicable law, and the remainder of this Agreement shall remain in full force and effect.
15. **Entire Agreement.** This document contains the entire agreement of the parties concerning the subject matter contained herein, and supersedes all prior and contemporaneous negotiations and understandings, both oral and written. This Agreement may not be amended or modified except by a separate written agreement signed by both parties.
16. **No Duty to Employ; "At Will" Employment.** I understand that this Agreement does not constitute a contract of employment or obligate the Company to employ me for any stated period of time. I understand that I am an "at will" employee of the Company and that my employment can be terminated at any time, for any reason or for no reason, by either the Company or myself. This Agreement shall be effective as of the first day of my employment by the Company, namely:
Jan. 12, 1999

Company:

By: [Signature]

Name: Susan Iola

Title: HR Representative

Employee:

Signature

[Signature]
Name (Please Print) John Comito

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2. **Disclosure of Inventions.** I will promptly disclose in confidence to the Company all inventions, improvements, designs, original works of authorship, formulas, processes, compositions of matter, computer software programs, databases, mask works and trade secrets ("Inventions") that I make or conceive or first reduce to practice or create, either alone or jointly with others, during the period of my employment, whether or not in the course of my employment, and whether or not such Inventions are patentable, copyrightable or protectible as trade secrets.
3. **Work for Hire; Assignment of Inventions.** I acknowledge and agree that any copyrightable works prepared by me within the scope of my employment are "works for hire" under the Copyright Act and that the Company will be considered the author and owner of such copyrightable works. I agree that all Inventions that (i) are developed using equipment, supplies, facilities or trade secrets of the Company, (ii) result from work performed by me for the Company, or (iii) relate to the Company's business or current or anticipated research and development (collectively "Assigned inventions"), will be the sole and exclusive property of the Company and are hereby irrevocably assigned by me to the Company.
4. **Labor Code 2870 Notice.** I have been notified and understand that the provisions of paragraphs 3 and 5 of this Agreement do not apply to any Assigned Invention that qualifies fully under the provisions of Section 2870 of the California Labor Code, which states as follows:

(a) Any provision in an employment agreement which provides that an employee shall assign, or offer to assign, any of his or her rights in an invention to his or her employer shall not apply to an invention that the employee developed entirely on his or her own time without using the employer's equipment, supplies, facilities, or trade secret information except for those inventions that either:

- (1) Relate at the time of conception or reduction to practice of the invention to the employer's business, or actual or demonstrably anticipated research or development of the employer; or
- (2) Result from any work performed by the employee for the employer.

(b) To the extent a provision in an employment agreement purports to require an employee to assign an invention otherwise excluded from being required to be assigned under subdivision (a), the provision is against the public policy of this state and is unenforceable.

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5. **Assignment of Other Rights.** In addition to the foregoing assignment of Assigned Inventions to the Company, I hereby irrevocably transfer and assign to the Company: (i) all worldwide patents, patent applications, copyrights, mask works, trade secrets and other intellectual property rights in any Assigned Invention; and (ii) any and all "Moral Rights" (as defined below) that I may have in or with respect to any Assigned Invention. I also hereby forever waive and agree never to assert any and all Moral Rights I may have in or with respect to any Assigned Invention, even after termination of my work on behalf of the Company. "Moral Rights" mean any rights to claim authorship of an Assigned Invention, to object to or prevent the modification of any Assigned Invention, or to withdraw from circulation or control the publication or distribution of any Assigned Invention, and any similar right, existing under judicial or statutory law of any country in the world, or under any treaty, regardless of whether or not such right is denominated or generally referred to as a "moral right."
6. **Assistance.** I agree to assist the Company or its designee in every proper way to obtain for the Company or its designee and enforce for the Company or its designee patents, copyrights, mask work rights, trade secret rights and other legal protections for the Company's Assigned Inventions in any and all countries. I will execute any documents that the Company or its designee may reasonably request for use in obtaining or enforcing such patents, copyrights, mask works, trade secrets and other legal protections. My obligations under this paragraph will continue beyond the termination of my employment with the Company, provided that the Company or its designee will compensate at a reasonable rate after such termination for time or expenses actually spent by me at the Company's request on such assistance. I appoint the Secretary of the Company as my attorney-in-fact to execute documents on my behalf for this purpose.
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Sep 14, 1998.

Company:
By: [Signature]
Name: Susan Cole
Title: HR Rep.

Employee:
[Signature]
Signature
Jeremy Edwards
Name (Please Print)